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Supreme Court of the United States

OCTOBER TERM, 1930.

No. 19.

LEKTOPHONE CORPORATION, *Petitioner,*

vs.

THE ROLA COMPANY.

OCTOBER TERM, 1930.

No. 68.

MILLER BROTHERS COMPANY, *Petitioner,*

vs.

LEKTOPHONE CORPORATION.

ON WRITS OF CERTIORARI TO THE UNITED STATES CIRCUIT COURTS OF APPEALS FOR THE NINTH CIRCUIT AND FOR THE THIRD CIRCUIT.

PETITION FOR REHEARING.

WILLIAM H. DAVIS,
of Counsel.

GALLO & ACKERMAN, Inc., 142 Liberty Street. 'Phones—Hitchcock 8078-9.

Supreme Court of the United States

NOS. 19 AND 68—OCTOBER TERM, 1930.

LEKTOPHONE CORPORATION, *Petitioner,* vs. THE ROLA COMPANY, *Respondent.*	On writ of certiorari to the United States Circuit Court of Appeals for the Ninth Circuit.
MILLER BROTHERS COMPANY, *Petitioner,* vs. LEKTOPHONE CORPORATION, *Respondent.*	On writ of certiorari to the United States Circuit Court of Appeals for the Third Circuit.

PETITION FOR REHEARING.

Now comes Lektophone Corporation, and petitions this Honorable Court for a reconsideration and rehearing of the above-entitled cause because:

I. It is not true that Hopkins' disclosure included "tightly gripping and rigidly supporting the outer edge of the cone between two rings" (Opinion, p. 2).

No other Court in this country or abroad has ever before attributed a gripping of the edge of the cone to Hopkins' disclosure. The truth is that Hopkins intro-

duced between the cone and the rigid clamping rings "an annular plane peripheral portion or supporting rim *l*" (pat., p. 2, lines 74-75) which "yields sufficiently to permit of the required motion of the conical portion" (Appln., Tr., 337) whereby "the intended object, a simultaneous movement of the whole conical portion of the tympanum, is thus attained" (pat. p. 2, lines 121-122). That was the holding in the "several cases in the lower courts and abroad" (Opinion, p. 2), including the decisions of Judge Thacher and of Judge Hickenlooper (*post*, pp. 3 and 4) and of Mr. Justice Tomlin (Pamphlet, p. 209).

II. The question of infringement cannot reasonably be adjudicated without determining whether defendants' leather (or cloth) rim is functionally equivalent in the combination to this "annular plane peripheral portion or supporting rim *l*" of Hopkins.

III. Judgment of the question of infringement without determining that, overturns that reasonable and important milepost of patent interpretation erected by this Court, after a long-continued struggle, in the Paper Bag Patent Case, 210 U. S., 405. It sets up again the discredited, empirical and unreasonable rule rejected by this Court in that famous case.

ARGUMENT.

I.

(a) The "annular rim which encircles said conical portion and which is rigidly supported" defined in the eighth claim of the patent (for example) is an essential element of the patented three-element combination. It absolutely excludes the idea that the edge of the cone is gripped by the rings.

(b) The "result claimed for the rigid support" (Opinion, p. 2) cannot be attained in accordance with the invention by gripping the outer edge of the cone between the rigid rings. That would inhibit the bodily movement of the conical portion which it was the patentee's express object to attain.

(c) Erring on this essential fact, the opinion of this Court mistakenly suggests (pp. 2-3) that its finding is in accord with that of Hickenlooper, J., in the *Crosley case.* The basis of Judge Hickenlooper's opinion was very different from—specifically it was just the antithesis of—the finding of this Court.

The basis of Judge Hickenlooper's opinion was that the Hopkins combination **includes** (Pamphlet, p. 63):

> "an annular rim interposed between the rigid support and the conical portion, to maintain the place of the conical active portion, and yield sufficiently to permit the required motion of the conical portion, * * *"

and that the Crosley device did not infringe because (Pamphlet, pp. 63-64):

> "The periphery or base of the cone **does not,** however, **terminate in an annular rim interposed between the rigid support and the conical portion**"

and (Pamphlet, p. 71):

> "* * * the patentee here is limited to a diaphragm **having the annular rim, rigidly held,** and to a comparatively narrow range of equivalents. **The loose rubber ring of Brandes may be such equivalent but the total absence of any annulus cannot be so considered.**"

Where Judge Hickenlooper held that the patented three-element combination **includes** an annular rim and Crosley's device did not infringe because it had **no such rim**; this Court erroneously finds that Hopkins' rings clamp the edge of his cone, and that defendants' devices do not infringe because they **have** a flexible rim interposed between the cone and the rings.

(d) This Court says (Opinion, p. 3):

> "The plaintiff's cone, of crisp, strong, more or less rigid material, is continued in one piece under the rings that give it a rigid support. Its tympanum includes this outer edge."

But the rings do not give plaintiff's cone a rigid support. The rings clamp only the outer edge of the rim. The greater portion of the width of the rim lies between the cone and the rigid rings and affords a yielding support for the cone.*

(e) The remarks quoted by this Court (Opinion, p. 3) from the opinion of Judge Thacher in the *Western Electric case* are erroneously applied to defendants' constructions here. Of the double cone *Western Electric* construction, Judge Thacher said:

> "* * * the defendant's structure, although it comprises a tympanum support having a circular aperture, does not comprise a tympanum having its outer edge rigidly mounted on said support in said aper-

*In the manufactured "Actuelle" phonograph loudspeaker, the yielding portion of the rim between the cone and the frame was a single deep corrugation or gutter, following the suggestion of the patent (p. 2, lines 127-129) that—

> "it is possible to form radial or concentric corrugations in the plane peripheral portion *l*."

> ture within the meaning of claim 4. Nor does it comprise an annular rim which encircles the conical portion of the tympanum within the meaning of claim 8." (20 Fed. [2d], 154.)

and

> "* * * to hold that the defendant's device comprises a 'tympanum rigidly supported at its periphery' within the meaning of the claims is to construe the claims contrary to the plain import of their terms." (20 Fed. [2d], 154.)

These remarks by Judge Thacher, quoted by this Court in its opinion (p. 3) were based on the fact that the tympanum support in the *Western Electric* contrivance lay **inside** of the circumference or outer edge of the cone; the inturned cone frustum did not encircle but lay **inside** of the conical portion of the tympanum. In defendants' devices here, the annular rim certainly encircles the conical portion and the outer edge of the rim is rigidly mounted in the rings.

The "experiments that showed the difference in function of the two devices" to which this Court refers (Opinion, p. 3) were the Stroboscope experiments which convinced Judge Thacher that in the *Western Electric* contrivance (20 Fed. [2d], 154):

> "There was **no bodily movement** of the front cone as a whole, which **did not, as it obviously could not, move upon the frustum of the rear cone as a hinge, the joint between the two cones being rigid and inflexible.**"

He therefore found no infringement because, as he had held, the Hopkins invention is characterized by—

> "the method devised for supporting the edges of the vibrating cone by means of **a flexible annular rim**" (20 Fed. [2d], 154)

and

> "**This bodily movement** of the comparatively stiff and rigid cone [observed when the Hopkins device is looked at under a Stroboscope] **is,** of course, **made possible by the flexible annular rim, the function of which is to serve as a hinge permitting bodily movement of the cone**" (*idem*).

The *Miller* device here adjudicated was subjected to the same Stroboscope experiment and unlike the *Western Electric* contrivance was observed **to have the same bodily movement of the comparatively stiff and rigid cone made possible by the flexible annular rim, which characterizes the Hopkins combination** (Miller, Tr., 167—Exhibit O).

Thus, the experiment which, applied to the *Western Electric* contrivance, showed a mode of operations different from Hopkins; showed, when applied to the defendants' structure here, the same mode of operation as Hopkins. It was clear error for this Court to assume the contrary.

The quite specific interpretation of Hopkins' claims that brings within them the single cone structure used by defendants here was not negatived by Judge Thacher's exclusion of the double cone *Western Electric* contrivance, affirmed by the Second Circuit Court of Appeals. That was recognized in the sound decision by Galston, J., in the *Colonial case* (Pamphlet, p. 112).

(f) The question of size assumes a wholly different aspect when the functional relationship of Hopkins' plane peripheral rim is analyzed and understood; but in any event the larger of the Miller cones is of the size mentioned in the Hopkins patent; as is also the Colonial loudspeaker held to be an infringement by Judge Galston in the *Colonial case* (Pamphlet, p. 112). The privilege of manufacturing these large cone type loudspeakers is thus

seen to be of very substantial industrial importance; whether the patent is or is not avoided by a structure having a cone of the full area of Hopkins' conical portion, but made of less overall diameter by using an annular rim of more flexible material.

II.

When it is thus recognized that Hopkins' combination included an interposed yielding rim, the question whether defendants' leather (or cloth) rim is functionally equivalent in the combination to the "annular plane peripheral portion or supporting rim *l*" of Hopkins presents itself. Once the question is thus concretely postulated, it must be answered in plaintiff's favor on the testimony of defendants' own witnesses in both cases.*

III.

In our brief in the *Miller case,* we discussed (pp. 19-20) the established rule of patent interpretation which calls for determination of this question of functional relationship in the combination, apart from the intrinsic attributes of the different forms of rim; and in our brief in the *Rola case* (pp. 69-70) we discussed the decision of this Court in the *Paper Bag patent case* which definitely rationalized this important subject. If the decision in the instant case is allowed to stand, the result will be to introduce again into every patent litigation in which the question of equivalence arises, the old confusion and avoidable uncertainty that existed prior to the *Paper Bag patent case* decision; until laboriously, but surely,

*See the testimony of defendant's witnesses in the *Rola case* quoted in our brief in that case at page 20, and the testimony of defendant's expert in the *Miller case,* quoted at pages 21 and 33-35 of our brief in that case.

this Court shall at some future time be brought to a restatement of that sound and reasonable rule—a rule which it has so recently applied (but with a different composition of the Court and without explicit restatement of the rule) in *Temco* vs. *Apco*, 275 U. S., 319, and in *Sanitary, etc.*, vs. *Winter*, 280 U. S., 30.

We believe most sincerely that the errors of fact above pointed out led to erroneous conclusions of law, and that both ought to be corrected.

We call attention to the fact that the opinion of this Court in these cases will be of great interest to the industry and to the Courts and lawyers in all European countries, as well as in this country.

We present this petition, therefore, most respectfully; not only for the particular interest of our client, but also for a more general interest, having in mind the far-reaching reputation of this Court and of the distinguished author of the opinion.

Respectfully submitted,

WILLIAM H. DAVIS,
of Counsel.

I hereby certify that the foregoing petition for rehearing is well founded in law and fact, is filed in good faith, and is not filed for delay.

WILLIAM H. DAVIS.